

Attorney Docket No. 3495.0111-11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:)

Bernard DUJON et al.)

Serial Number: 09/492,697)

Filed: January 27, 2000)

Group Art Unit: 1633

TECH CENTER 1600/2900

Examiner: KAUSHAL, S.

For: NUCLEOTIDE SEQUENCE ENCODING
THE ENZYME I-SCEI AND THE USES THEREOF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

AMENDMENT AND RESPONSE TO PAPER NO. 4

In response to the Office Action dated June 6, 2000 (Paper No. 4), the period for response to which has been extended by filing a petition for three month extension of time and fee concurrently herewith, applicants submit the following amendments and remarks.

IN THE SPECIFICATION:

Please insert the attached page 1 of U.S. Appl. Ser. No. 08/336,241 entitled "CROSS REFERENCE TO RELATED APPLICATION" after the title page.

IN THE CLAIMS:

Please cancel claims 24 and 31.

Please amend the following claims:

D' 23. (Amended) A recombinant mammalian or plant chromosome comprising [an endonuclease site selected from the group consisting of HO endonuclease and] a Group I intron encoded endonuclease [sites] site.

In claim 25, line 1, delete "24" and insert therefor --23--.

In claim 32, line 1, delete "31" and insert therefor --30--.

REMARKS

Reconsideration of this application is respectfully requested. Claims 23, 25, and 32 have been amended and claims 24 and 31 have been canceled to facilitate prosecution of this application. Applicants expressly reserve the right to reintroduce this subject matter into the pending claims. No new matter enters by amendment. Upon amendment, claims 23, 25-30, and 32-44 are pending in this application with claims 38-44 withdrawn from consideration.

The Examiner contends that the application is missing page 1 of the specification. Applicants provide herewith page 1 of U.S. Appl. Ser. No. 08/336,241.

M.P.E.P. § 201.06(c) states:

Since the specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) are not limited to a reproduction or "true copy" of the prior application, the safeguard in former 37 CFR 1.60(b) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 CFR 1.53(b). Nevertheless, an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of

this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.

The instant continuation application was filed on January 27, 2000, under 37 C.F.R. § 1.53(b). U.S. Application Ser. No. 08/336,241 was incorporated by reference in applicants' January 27, 2000, transmittal letter for the instant application. (See applicants' January 27, 2000, Request for Filing a Continuation Application at 2.) The enclosed page of the specification corresponds to page 1, as originally filed, in U.S. Application Ser. No. 08/336,241. Therefore, no new matter enters by the addition of this page to the instant application.

The Examiner required restriction to the claims of Group I (claims 23-37) or the claims of Group II (claims 38-44). Applicants affirm the election of the claims of Group I (claims 23-37) for examination in this application.

The Examiner also requires applicants to affirm the election of I-SceI endonuclease. Applicants affirm the election of the species of I-SceI endonuclease.

However, the Examiner further requires restriction to one of the gene families of:

- a) HO endonuclease sites, and
- b) Group-I intron encoded endonuclease sites.

The Examiner states that "[t]he claims must be amended according to the election herein since the claims as presently drafted contain non-elected subject matter which has been withdrawn from consideration. The claims as currently drafted if free of rejections could not be indicated as allowable until the non-elected subject matter is

removed from the generic claims." (Paper No. 4 at 4.) Applicants traverse this requirement.

M.P.E.P. § 809 states:

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP Section 809.03 for definition of linking claims.

A letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered linking. See MPEP Section 812.01 for telephone practice in restriction requirements. . . . **To be complete, a reply to a requirement made according to this section need only include a proper election.**

The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability.

As discussed above, applicants have elected the species of I-SceI endonuclease. Pending claims 23-37 read on the elected species¹, and claim 23 and 30 are generic claims linking HO endonuclease and Group I intron encoded endonuclease sites. Accordingly, applicants respectfully submit that the Examiner must examine pending claims 23-37. See M.P.E.P. § 809.

¹ The Examiner indicated that claims 24-27 and 31-34 were generic claims. (Paper No. 4 at 3.) Applicants point out that claims 23 and 30 are also generic claims that read on I-Sce I endonuclease, which is the elected species.

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However, solely to expedite prosecution of this application, applicants have amended claim 23 to remove the recitation of "HO endonuclease." Accordingly, applicants submit that the Examiner's requirement is moot.

Claims 23-37 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,948,678.

Solely to expedite allowance of the pending claims, and not in acquiescence to this rejection, applicants submit herewith Terminal Disclaimers in compliance with 37 C.F.R. § 1.321(b) from Institut Pasteur and from Universite Pierre et Marie Curie.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 5, 2000

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